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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,792	03/30/2000	Vincenzo Scotto Di Carlo	GR 97 P 2659	7892

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Lerner and Greenberg PA
Post Office Box 2480
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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/538,792

Applicant(s)

DI CARLO ET AL.

Examiner

Joseph T Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Priority

Acknowledgement is made of applicant's claim for priority from an international application. However, the priority is not granted because applicant has not complied with the requirements of 35 U.S.C. 371. Appropriate submittal is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 7, lines 5-7, it is unclear as to what extent is meant by "at least partially"

This phrase will be removed and interpreted as such in this office action.

Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the

requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-12 rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al., Patent No. 6333973.

Regarding claim 1, Smith teaches a method of notifying a subscriber of a plurality of message services of a message:

indicating, with each of a plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service (*col.3 lines 50-54; the network services provider in Smith is the common notification server*); and transmitting, with the notification server, to at least one terminal of the subscriber a notification indicating that a new message is present and in which message service the new message is present (*col.4 lines 1-3 and col.8 lines 40-45*).

Regarding claim 2, Smith teaches the method according to claim 1, which comprises, if a message service indicates the presence of a new message, storing with the notification server the data originating from the message service, until the respective notification has been transmitted successfully (*col.4 lines 50-56*).

Regarding claim 3, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to all terminals of the subscriber (col.3 lines 50-54).

Regarding claim 4, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to the notification server to at least one terminal selected by the subscriber from a plurality of terminals (col.10 lines 30-37).

Regarding claim 5, Smith teaches the method according to claim 4, wherein the subscriber selects a terminal by transmitting a control information item from the respective terminal to the notification server (col. 10 lines 30-37)

Regarding claim 6, Smith teaches the method according to claim 1, which comprises transmitting with each message service a message header information item to the notification server when a new message is present, and transmitting the message header information with the notification server at least partially to at least one subscriber terminal enabled, at least partially, to output the message header information (col.8 lines 36-45).

Regarding claim 7, Smith, as best understood due to the confusion above, teaches the method according to claim 1, which comprises, in response to a request by the notification server, transmitting with each message service a message header information item to the notification server, and transmitting the message header information item with the notification server to at least one subscriber terminal enabled to output the message header information (col. 8 lines 36-45).

Regarding claim 8, Smith teaches the method according to claim 1, which comprises, in response to a subscriber request from any terminal, firstly performing an authorization check with the notification server and then transmitting the notifications present to the terminal (col. 10 lines 8-15 and 50-56).

Regarding claim 9, Smith teaches the method according to claim 1, which comprises processing with the notification server the data originating from the message services for generating the notifications transmitted to the subscriber (col.10 lines 5-10 and 18-25).

Regarding claim 10, Smith teaches the method according to claim 9, wherein the processing step comprises selecting one or more processes from the group consisting filtering, ordering, and formatting the data (*col.10 lines 48-56; by pressing the "View" button, Smith orders the data from the notification server*).

Regarding claim 11, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a signaling operation to the at least one terminal of the subscriber (*Fig.1-the signaling path from label 1100 through 1800 to 1200*).

Regarding claim 12, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a call set-up to the at least one terminal of the subscriber (1300 Fig.1 and col.4 lines 15-24).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fortman et al., Patent No. 5,987,100 teaches a universal mailbox

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including a messaging center that stores incoming messages and notifies a subscriber to retrieve.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP
May 20, 2002

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', is written below the printed name and title.